REMARKS

By this Amendment, Applicants have amended claims 1, 13, 25, and 37. Support for the amendments to the claims can be found in the specification at, for example, page 6, ¶ [027]; page 14, ¶¶ [048] and [049]; and page 16, ¶ [056], among other places. No new matter is introduced. Accordingly, claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 are pending.

Summary

The final Office Action rejected claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,422,821 to Allen et al. ("Allen") in view of U.S. Patent Application Pub. No. 2002/0029202 A1 to Lopez et al. ("Lopez") and in further view of a webpage for "NCOA Description" from www.anchorcomputer.com (Reference U of the PTO-892) ("Anchor").

Rejection of Claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established with respect to these claims.

To establish a *prima facie* case of obviousness, the final Office Action must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. *See* M.P.E.P. § 2144.08(II)(A). Furthermore, the final Office Action must make findings with respect to all of the claim limitations and must make "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *See Id.* §§ 2143.03 and 2141(III).

Amended claim 1 recites, among other things, the following features:

> receiving a first instance of an incorrect address that contains an error that is correctable to match a predetermined deliverable address format, the incorrect address being associated with a first item . . .
>
> storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the error that is correctable to match the predetermined deliverable address format; [and] . . .
>
> comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address.

According to amended claim 1, the first instance of an incorrect address "contains an error that is correctable to match a predetermined deliverable address format" (emphasis added), such as, in one exemplary embodiment, having "an incorrect or missing ZIP code," which does not match the format specified in a ZIP+4 database, but is nevertheless correctable to match the format specified in the ZIP+4 database, as disclosed in the specification at page 14, lines 9-12, and page 14, line 19 to page 15, line 2. Furthermore, amended claim 1 also recites "storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the error that is correctable to match the predetermined deliverable address format; [and] . . . comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address" (emphases added). Applicants submit that at least the above combined features are not taught or suggested by Allen, Lopez, and Anchor, whether taken alone or in any combination.

As discussed in Applicants' previous response filed February 18, 2009, Allen teaches an apparatus for intercepting and forwarding incorrectly addressed mail pieces. The address on a mail piece is compared with the addresses in the USPS National Change of Address (NCOA) database, which contains the name and former address of each addressee who has filed a change of address form with the USPS, to determine if a forwarding request has been logged. *Id.*, col. 6, line 65 to col. 7, line 4. Allen refers to the address on a mail piece as an "incorrect" address when it is the "former" address, as opposed to the current address, for the addressee. *See Id.*, col. 6, lines 11-19. *See also Id.*, col. 2, lines 38-41, stating that "[i]f the read . . . address match[es] . . . [the] former address . . . , then the mailpiece is identified as having an incorrect address." Allen's "former address" on a mailpiece does not contain any errors, because if it did, then it would not match the stored former address. Thus, the "incorrect address" as taught by Allen is not an "incorrect address that contains an error that is correctable to match a predetermined deliverable address format," as recited in amended claim 1.

The final Office Action contends that "[t]he incorrect address of Allen is an address that is not inaccurate. The reason for the inaccuracy . . . is irrelevant." Final Office Action, p. 2. Applicants respectfully disagree. What constitutes an incorrect address is certainly relevant to the claimed invention, given that claim 1, as amended, recites an "incorrect address" as being an address "that contains an error that is correctable to match a predetermined deliverable address format." Allen simply does not teach or suggest an incorrect address, as recited in amended claim 1.

Accordingly, for at least the above reasons, and in light of the amendments to claim 1, Allen does not teach or suggest "receiving a first instance of an incorrect

address that contains an error that is correctable to match a predetermined deliverable address format, the incorrect address being associated with a first item," as recited in amended claim 1. This is consistent with the final Office Action's admission on p. 3, stating that "Allen does not explicitly teach the limitation . . . [of] receiving a first instance of an incorrect address . . . [as recited in claim 1]."

Similar to its failure to teach or suggest "receiving . . . an incorrect address . . . ," as recited in amended claim 1, Allen also does not teach or suggest "storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the error that is correctable to match the predetermined deliverable address format," as recited in amended claim 1 (emphases added). Moreover, this feature demonstrates one of the significant differences between the claimed invention and the cited prior art, including Allen.

In addition, because Allen does not teach or suggest the "incorrect address that contains an error and does not match a predetermined deliverable address format," or "storing . . . the incorrect address that contains the error that is correctable to match the predetermined deliverable address format," as recited in amended claim 1 (emphasis added), Allen also does not teach or suggest "comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address," as recited in amended claim 1 (emphasis added). Allen merely teaches comparing an address from a mailpiece with former addresses contained in the NCOA database. *See* Allen, *e.g.,* at col. 2, lines 57-67. However, the former addresses stored in the NCOA

database is not equivalent to the claimed "incorrect address," for the reasons explained above.

The final Office Action relies on Lopez and Anchor to allegedly cure the deficiencies of Allen. Lopez discloses "[a] system and methods for routing mailpieces undeliverable as originally addressed." Lopez, Abstract. Lopez, however, does not teach or suggest, among other things, at least "storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the error that is correctable to match the predetermined deliverable address format," as recited in amended claim 1 (emphases added). Lopez also does not teach or suggest "comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address [which contains the error that is correctable to match the predetermined deliverable address format]," as recited in amended claim 1 (emphasis added). The final Office Action admits that "Allen in view of Lopez does not explicitly teach the limitation [of] . . . storing a resolved address in a database . . . the resolved address comprising . . . the first incorrect address record." Final Office Action, pp. 3-4. Therefore, Lopez does not cure the deficiencies of Allen.

The final Office Action relies on Anchor to allegedly teach "storing . . . the first instance of the incorrect address that contains the error that is correctable to match the predetermined deliverable address format," as recited in amended claim 1 (emphasis added). The final Office Action refers to page 2, ¶¶ 7-8 of Anchor for this alleged teaching. Anchor merely teaches "process[ing] your list [of addresses] and mak[ing] all

necessary address corrections . . . [and] standardiz[ing] your addresses and add[ing] ZIP+4 Codes to your address file." Anchor, ¶ 7. Paragraph 8 of Anchor shows a table illustrating comparing addresses from a mail file with addresses from a NCOA database to obtain new addresses for forwarding mailpieces. However, neither ¶ 7 nor ¶ 8 teaches or suggests "storing . . . the first instance of the incorrect address that contains the error that is correctable to match the predetermined deliverable address format . . . [and] comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address," as recited in amended claim 1 (emphases added). Therefore, Anchor does not cure the deficiencies of Allen and Lopez.

For at least the foregoing reasons, Allen, Lopez, and Anchor, whether taken alone or in combination, fail to teach or suggest the features recited in amended claim 1, and the final Office Action incorrectly determined the scope and content of the prior art. Moreover, the undisclosed features represent significant differences between the claimed invention as a whole and the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1, and it is allowable over the cited references. Dependent claims 4-12 and 57-59 are also allowable, at least by virtue of their dependence from claim 1, as well as by virtue of reciting additional features not taught or suggested by the cited references.

Although of different scope, each of independent claims 13, 25, and 37 includes similar features as those recited in claim 1. For at least the same reasons presented above in connection with claim 1, each of independent claims 13, 25, and 37 is patentable over the cited references, and thus, is allowable. Dependent claims 16-25,

28-37, 40-48, and 60-64 are also allowable, at least by virtue of their dependence from independent claims 13, 25, or 37, as well as by virtue of reciting additional features not taught or suggested by the cited references.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

The final Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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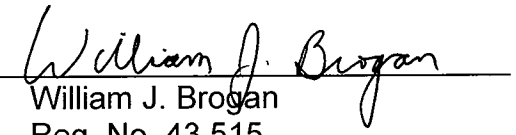
Dated: September 14, 2009

By: 
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